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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,607	12/13/2000	George M. Brookner	770P009578-US	2526

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PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,607

Applicant(s)

BROOKNER ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-14, 29-61, 63 and 76-108 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 11-14, 34-61, 63, 77-98 and 104-106 is/are allowed.
- 6) ☒ Claim(s) 29-33, 76, 99-103, 107 and 108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and

C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.

2. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

3. Claims 29-33, 76, 99-103, 107 & 108 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3.1 Claims 29-33, 76 & 101-103 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:

A) in regard to claims 29-33, 76 & 101-103, the preamble of these claims indicates that the purpose of this claim is to generate a indicium indicative of payment, however, this claim merely recites:

(1) a printed head for printing information; and

(2) a sensor encapsulated in potting material for detecting an intrusion to the connection supplying data to the print head, where a detected intrusion terminates the operation of the print head;

however, since these claims fails to recite that the indicia is either:

(1) actually printed;

(2) actually generated; or

(3) actually required to be associated with any type of payment,

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these claims clearly fail to accomplish the intended purpose of the claimed invention, that is generating an indicia indicative of a payment.

For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

3.2 In regard to claims 99 & 100, these claims are vague and indefinite, since these claims depend from cancelled claim 15, and hence neither the scope nor meaning of these claims can be determined.

3.3 In regard to claim 107, this claim is vague and indefinite, since this claim depends from cancelled claim 21, and hence neither the scope nor meaning of this claim can be determined.

3.4 In regard to claim 108, this claim is vague and indefinite, since this claim depends from cancelled claim 69, and hence neither the scope nor meaning of this claim can be determined.

3.5 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

4.1 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example, either Calvi (4,580,144) or Sansone et al (4,673,303) or Gilham (5,122,967 or 5,200,903 or 5,408,416) or Abumehdi

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(5,508,933) or Naclerio et al (5,583,779) or Windel et al (5,680,463 or 5,712,916 or 5,734,723) discloses a postage metering system that dispenses and accounts for the postage used by the system. Once postage is to be dispensed, these systems combine variable and fixed data to form the postage indicia and mail piece. Next, the data is printed on either a strip of tape, that is a label, or the mail piece.

B) however in regard to claims 1 & 54, the prior art does not teach or suggest the printing of the indicia on the adhesive side of self adhesive transparent label stock. Claims 1-9, 11-14, 55-61, 63, 96-98, 104-106 are allowable for the same reason.

C) however in regard to claims 29 & 76, the prior art does not teach or suggest the disabling of the printer when tampering has been detected. Claims 30-33, 78-83 & 101-103 are allowable for the same reason.

D) however in regard to claims 34 & 77, the prior art does not teach or suggest the printing of a non-fluorescent postage indicia on a fluorescent medium. Claims 35-41 & 78-83 are allowable for the same reason.

E) however in regard to claims 42 & 84, the prior art does not teach or suggest the printing of machine readable information at two separate locations on the mail item, where one of the machine readable information is for error correction. Claims 43-49 & 85-91 are allowable for the same reason.

F) however in regard to claims 50 & 92, the prior art does not teach or suggest the printing of machine readable information at two separate locations on the mail item where one of the machine readable portion includes an indication that associates the two machine readable portions. Claims 51-53 & 93-95 are allowable for the same reason.

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

6.2 As per the 35 U.S.C. § 112 2nd paragraph rejection, since the rejection sets forth that one of ordinary skill would clearly recognize that what is claimed as the intended purpose of the claims 29-33, 76 & 101-103 that is "generating an indicia indicative of payment" is not accomplished by these claims, and hence applicant has failed to distinctly and particularly point

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out what is the claimed invention by misleading one of ordinary skill as to what is the claimed invention. Therefore, applicant's argument's are non persuasive.

7. Claims 29 & 76 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112. Claims 30-33, 99-103, 107 & 108 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 C.F.R. § 1.111(b) and section 707.07(a) of the M.P.E.P.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

8.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

8.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

8.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

11/12/03


Edward R. Cosimano

Primary Examiner A.U. 3629